



UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/900,360 07/25/97 OBRECHT

W 2569-0103P

002292 TM02/0507
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

EXAMINER

MEINECKE DIAZ, S

ART UNIT

PAPER NUMBER

2163

DATE MAILED:

05/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS

Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 08/900,360

Filing Date: July 25, 1997

Appellant(s): Obrecht

MAILED

MAY 04 2001

Technology Center 2100

Donald J. Daley (Reg. No. 34,313)
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed March 12, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: 2163

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

Art Unit: 2163

(7) *Grouping of Claims*

The Appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the Appellant's arguments regarding the novelty of claims 2-9 all rely on the arguments already addressed in independent claim 1, from which they all depend. Furthermore, the Appellant admits in the Appeal Brief that claims 10-18 "recite a system which is related to the method, but the Office Action does not give any reasons merely saying that the subject matter claimed is obvious over the method" (page 15 of Appeal Brief). Additionally, similar arguments are relied upon for claims 19 and 20. Therefore, the Examiner asserts that claims 1-20 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,592,375

Salmon et al.

1-1997

- ① "Interactive Buyers Net: Buyer/Seller Interactive Software Inc. Acquired, New Software Introduced." Business Wire (August 22, 1995), Reference "U".
- ② "IBNL Announces Signing of More than \$8 Billion in Buying Power." Business Wire (November 15, 1996), p. 11151062, Reference "V".

Art Unit: 2163

- 3 "IBNL Declares 20 Percent Stock Dividend; SOURCE Interactive Software Systems Operational." Business Wire (December 14, 1995), p. 12141036, Reference "W".
- 4 ✓ "IBNL Forges into the Future of Buying and Selling with Source Interactive Software." PR Newswire (January 10, 1996), p. 110LAW034, Reference "X".
- 5 ✓ "IBNL Restructures Capitalization; Adds Proven Management; Releases Its New 'Virtual Source' Software." Business Wire (November 12, 1996), p. 11120218, Reference "U(2)".
- ⑥ Information about Vsource. Retrieved from the Internet [URL: <http://www.vsource.net>] on February 7, 2000, Reference "V(2)".

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the product *Source Interactive Software* (herein referred to as *Source Interactive* or *Interactive Source*, described in references U, V, W, X, U(2), and V(2)) in view of Salmon et al. (U.S. Patent No. 5,592,375). This rejection is set forth in sections 3-5 of Paper No. 11.

Art Unit: 2163

(11) Response to Argument

(A) The Appellant states:

“In an Office Action dated February 17, 2000 in the rejection references U, V, W, X, U2, and V2 were relied on as the base reference. In a telephone interview with the Supervisor, on May 25, 2000, the Supervisor, after an inquiry by the undersigned, stated that ‘the body of the rejection only recites references U, V, X, and Salmon.’ This statement was faxed to the undersigned and is part [of] the Official File Wrapper.

“In the Final Office Action, the Patent Office has again set forth that the references applied were the same references set forth in the Office Action dated February 17, 2000. This appears to contradict the statement of the Supervisor. While this is an inter-Patent Office matter, it is requested that the Patent Office clarify their position to make the record clear.” (Pages 4-5 of Appeal Brief)

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the product Source Interactive Software (herein referred to as *Source Interactive* or *Interactive Source*, described in references U, V, W, X, U(2), and V(2)) in view of Salmon et al. (U.S. Patent No. 5,592,375). This rejection is set forth in sections 3-5 of Paper No. 11. Although all of the references cited in the preamble of the rejection were not explicitly referenced in the body of the rejection, they all still contribute to the product description and are therefore valid supporting references. Furthermore, it is not clear how this statement “appears to contradict the statement of the Supervisor.” The Examiner agrees with the Supervisor’s Interview Summary (Paper No. 12), which merely states, “The body of the rejection only recites references U, V, X & Salmon.” Again, the claims were rejected over the product *Source Interactive Software* in view of Salmon

Art Unit: 2163

et al. Since the product as a whole was referenced in the body of the rejection, there is no requirement that all of the supporting references of the product *Source Interactive Software* be explicitly cited as well. They are at the very least implicitly incorporated whenever the product *Source Interactive Software* is referenced.

The Examiner asserts that references U, V, W, X, U(2), and V(2) were used to show the history of the product *Source Interactive Software*. Claims 1-20 were rejected over the product *Source Interactive Software* in view of Salmon. Examiner Crecca explained, in paper no. 11, why claims 1-20 were deemed obvious in light of the product *Source Interactive Software* in view of Salmon. She met her burden of establishing a prima facie case by adequately addressing the rejection of claims 1-20 over the product *Source Interactive Software* in view of Salmon and was under no obligation to cite each and every supporting reference in the body of the rejection since all references *collectively* contribute to the description of the product *Source Interactive Software*.

(B) The Appellant argues that references U(2) and V(2) are invalid prior art since they were published after the filing date of the present invention (page 5 of Appeal Brief); however, the Appellant is reminded that claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the product *Source Interactive Software* (herein referred to as *Source Interactive* or *Interactive Source*, described in references U, V, W, X, U(2), and V(2)) in view of Salmon et al. (U.S. Patent No. 5,592,375). The Examiner has established a prima facie case that references U(2) and V(2) further describe the product *Source Interactive Software* as it existed as far back as in 1995 (the product dates back to at least August 22, 1995, but it was officially

Art Unit: 2163

named *Source Interactive Software* by November 15, 1995). The Appellant has failed to adequately challenge the Examiner's prima facie case; therefore, references U(2) and V(2) are asserted to be valid references. Consequently, any of the Appellant's arguments which ignore the validity of references U(2) and V(2) in their justification are deemed to be moot.

(C) The Appellant argues the following:

"The quotation from reference 'X', paragraph 8, does not at all meet the steps in, for example, claim 1 (c) and (d). In the 'X' reference, the sellers first identify their products and when a buyer sends out a request that matches the category, sellers are connected to the request of the buyers. This is completely different than the method steps set forth, for example, in base claim 1. Apparently, 'X' is describing a 'static system' as explained in the first full paragraph on pages 2 and 3 of the specification." (Page 11 of Appeal Brief)

The Appellant is reminded that the Examiner cited both paragraphs 5 and 8 (and not just paragraph 8) of reference "X" to teach claim limitations 1(c) and 1(d), respectively. Furthermore, the Appellant makes an assertion with no support. It is not clear what the basis for the Appellant's argument is. Claim 1 recites, among other limitations, step "(c) transmitting the request of the buyer to the selected at least one seller of the goods or services" and step "(d) receiving, within a predetermined time interval, responses from the at least one seller to the request." Paragraph 5 of reference "X" states that "SOURCE interactively delivers the buyer's request to appropriate sellers" (i.e., step (c)). Paragraph 8 of reference "X" explains that buyers are connected to customers with requests matching their offered products (i.e., step (d)).

Art Unit: 2163

(D) The Appellant argues that:

“...[T]he Patent Office then relies on Salmon to show, for example, ‘the ranking step of claim 1’.

“This step in the context claimed provides a ranking of the sellers. The Patent Office asserts that Salmon teaches such a ranking. This is traversed. What Salmon is doing is ranking the product itself such as real estate, automobiles, aircrafts, or yachts, etc. (see, for example, column 2, lines 18 and 19). This is quite different than what has been claimed in the method and article.

“In the present application, in the context claimed, it is the sellers who are ranked based on criteria set forth by the buyers. The products are not ranked. Also, there is no selecting ‘in the references applied.’” (Pages 11-12 of Appeal Brief)

Step (f) recites “ranking the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking.” By associating a product with a particular seller and then ranking each product, inherently the seller is being ranked with respect to his/her product. As a matter of fact, the Applicant’s own specification explains that the ranking of the sellers is commonly based on the extent to which their respective products match what the buyer is looking for. “Also, the quotes provided by the dealers are ranked on the report, wherein the quote of dealer 13 is the best match and is therefore labeled ‘A,’ dealer 14 is labeled ‘B,’ and dealer 15 is labeled ‘C’” (Page 21 of the specification). Presumably product information must come from each respective seller in the Salmon patent; therefore, by ranking products, the sellers are inherently ranked as well. Such a scenario meets one of the examples given in the specification and also meets the corresponding, broadly claimed limitations of claim 1 (i.e., step (f) in particular). Furthermore, the Applicant has not explicitly given any specific

Art Unit: 2163

definition to the term "ranking" which might preclude the validity of the Examiner's interpretation of the Salmon reference as anticipating steps (e) through (g) of claim 1.

Reference "X" teaches the recited selecting step, 1(b) (see paragraph 5 of reference "X"). The Appellant seems to imply that the selecting taught in the references is different from the Appellant's intended definition of selecting. The Appellant is reminded that he can be his own lexicographer; however, he fails to explicitly define his preferred interpretation of the word "selecting." This word is extremely broad in nature and the Examiner has no justification for reading the entire specification into one word. If the Appellant wants the word "selecting" to be interpreted in a way contrary to popular usage of the word, he must point out where in the specification "selecting" was explicitly defined or he must clearly incorporate the intended limitations of the word "selecting" in the claims themselves.

(E) The Appellant argues the following:

"While the Patent Office asserts that it would be obvious to combine the teachings of the references, there is no prima facie case of obviousness present at least for the two points as follows:

(1) the structure claimed and steps are not shown or suggested in the combination of references; or

(2) outside of the Applicants own disclosure there would be no motivation to combine the references.

"Point (1) has been discussed above. With respect to the motivation (point 2), it is not understood from the Office Action what Salmon would suggest to one skilled in the art in modifying the primary references V, X, or U. Again, it appears that the Patent Office only has concentrated on the obviousness of structure or steps which really have not been shown 'instead of the context of the claims regarding the subject matter as a whole.' See the recent case of In

Art Unit: 2163

re Dembiczak 50 USPQ2d 1614 (Fed. Cir. 1999).” (Pages 12-13 of Appeal Brief)

In response to Appellant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine references was based on the teachings found in the references themselves in addition to the knowledge generally available to one of ordinary skill in the art:

“It would have been obvious to combine the ‘compiling’ and ‘ranking’ steps of Salmon et al. into the *Interactive Source* product. *Interactive Source* utilizes a central system (ref. “X”, paragraph 5) which facilitates the collection of buyers’ request for goods/services and this system distributes the requests to qualified sellers/vendors. It would be obvious to use the same centralized system to gather and rank the responses from the sellers, as in Salmon et al., as both systems are used in facilitating difficult purchase decisions of goods/services which, due to a large number of diverse criteria, require evaluation and comparison. The ‘compiling’ and ‘ranking’ steps become necessary in order to simplify the decision making process by streamlining the responses into a logical order, thereby assisting the buyer in making an informed purchase decision.” (Pages 3-4 of Paper No. 11)

(F) The Appellant argues:

Art Unit: 2163

“In Salmon, while the Final Office Action, which incorporated the rejection, stated that the steps (e)-(g) were found in Salmon, this is traversed. In Salmon, there is no compiling information in the responses received from at least one seller to the request because in Salmon the data from the seller is already within the data base and there is no request submitted based on criteria to various sellers so that the sellers can be ranked. Also, in step (f), there is no ranking of sellers based upon the compiled information and selecting the sellers relative to the highest ranking. Only the products or services have been ranked in Salmon. Also, step (g), is ‘providing the compiled responses of the selected sellers for access by the buyer’. This is not shown or suggested by Salmon. In Salmon, there is no response by the selected sellers based on the criteria submitted by the buyers. In Salmon, again as stressed above, the information of the product has already been inserted into the data base for the buyers [to] make their request based on their criteria. Actually, Salmon relates more to a static system, which was discussed as conventional in the specification. See, for example, the last paragraph on page 2 of the specification and the first paragraph on page 3 of the specification. Thus, the combination of both references does not establish a *prima facie* of obviousness. Even combining the suggestions in the references applied, the steps and structure that has been claimed is not shown or suggested.” (Pages 13-14 of Appeal Brief)

Steps (e)-(g) in isolation are indeed disclosed by Salmon. Salmon’s sellers send in product and service information in response to a request for them to participate in Salmon’s seller-buyer matching system. This scenario meets the limitations of compiling information provided in the responses received from at least one seller to a request and providing the compiled responses of the selected sellers for access by the buyer. Furthermore, Salmon was mainly cited to teach the concept of ranking products and/or services, and inherently the provider/seller of these products and/or services as well (i.e., ranking the sellers based upon compiled seller information including

Art Unit: 2163

the plurality of criteria and selecting sellers with the relatively highest ranking). The product *Source Interactive Software* already teaches that the responses received from at least one seller in response to a direct request from the buyer are compiled (Ref. "X", see *at least* the following sentence from paragraph 8: "Sellers are connected to the requests of all on-line buyers"); therefore, the Examiner maintains that the combination of teachings gleaned from the product *Source Interactive Software*, Salmon, and the knowledge generally available to one of ordinary skill in the art at the time of Appellant's invention would have indeed yielded the claimed invention along with the necessary motivation. In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

(G) The Appellant states:

"In the Office Action, with respect to claim 2, 'a computer receives the request' (reference X, paragraph 5 and reference V, paragraph 4) were relied on. While there is no doubt that a computer is set forth in reference X it is the context of the claims which has been shown not to be obvious. The Applicants are not just relying on a computer. The Applicants are relying on the totality of what has been claimed." (Page 14 of Appeal Brief)

Art Unit: 2163

Since claim 2 only adds the limitation that “a computer receives the request” (in step (a)) and the Appellant agrees that a computer is taught, the patentability of claim 2 seems to lie in the novelty of claim 1. The arguments corresponding to claim 1 were already addressed above.

(H) The Appellant states:

“With respect to claim 3 ‘selecting is performed by a central computer’ (reference X, paragraph 5 was relied on). While paragraph 5 may suggest a computer, it does not suggest a central computer in the context claimed.” (Page 14 of Appeal Brief)

Since claim 3 only adds the limitation that “selecting is performed by a central computer” (in step (b)) and the Appellant agrees that a computer is taught, the patentability of claim 3 seems to lie in the novelty of claim 1. The arguments corresponding to claim 1 were already addressed above. Furthermore, paragraph 5 of reference “X” states that “buyers and sellers modem information to the IBNL *central system*” (*emphasis added*).

(I) The Appellant states:

“With respect to claim 4, it was asserted that reference V, paragraph 6 shows transmitting by an internet system. Even assuming that reference V, paragraph 6, shows an internet system, this is just part of the method and the structure steps in the context claimed is not shown or suggested.” (Page 14 of Appeal Brief)

Since claim 4 only adds the limitation that “transmitting is done by an internet system” (in step (c)) and the Appellant agrees that the internet is taught (since there are no arguments made that the internet is not taught), the patentability of claim 4 seems to lie in the novelty of claim 1.

Art Unit: 2163

The arguments corresponding to claim 1 were already addressed above. Further, it is not clear what is meant by “structure steps.” The Examiner typically associates structure with an apparatus claim and steps with a method claim.

(J) The Appellant states:

“With respect to claim 5, the rejection relies on reference X, paragraph 5.

“It is submitted that this is not shown in reference X, paragraph 5 in the context claimed.” (Page 15 of Appeal Brief)

The Appellant makes an assertion without support. The Appellant seems to merely argue that the cited references do not address the “context” of claim 5; however, the “context” of claim 5 seems to rely on the limitations set forth in independent claim 1. The arguments corresponding to claim 1 were already addressed above.

(K) The Appellant argues:

“With respect to claim 6, as explained above, Salmon does not show this feature and the statements in the rejection regarding obviousness are only based on conjecture. No evidence has been provided.” (Page 15 of Appeal Brief)

The Examiner addressed this issue in section (F) above. The same response to the argument applies.

(L) The Appellant argues:

“With respect to claim 7, the rejection relies on reference V, paragraph 6, but this paragraph has nothing to do with accessing by the buyer because as stated in paragraph 6 of V:

Art Unit: 2163

“The cost for unlimited system access and interactive use of source is \$360.00 annually, \$30.00 monthly (plus applicable sales taxes) and any cost related to modem or *internet* digital transmissions.” (*Emphasis added*, Page 15 of Appeal Brief)

Both the seller and buyer must access the *Source Interactive Software* and this excerpt says that they may do so via the Internet. Reference “X” goes one step further and announces that “the ability to conduct business over the Internet is planned for the first quarter of 1996” (paragraph 5).

(M) The Appellant states:

“With respect to claims 8 and 9, it was stated that reference U, paragraph 2 and reference X, paragraph 1. These claims are considered patentable at least for the same reasons as their base or intervening claims.” (Page 15 of Appeal Brief)

Please refer to the response to the arguments regarding the “base or intervening claims” above.

(N) The Appellant argues:

“Regarding claims 10-18, these claims recite a system which is related to the method, but the Office Action does not give any reasons merely saying that the subject matter claimed is obvious over the method. These claims set forth specific structure and their relationship which provides for the improved device. The rejection is really based on conjecture.” (Page 15 of Appeal Brief)

Art Unit: 2163

The Appellant admits that claims 10-18 “recite a system which is related to the method”; therefore, the rejection of claims 1-9 (the corresponding method claims) is applicable to claims 10-18 as well. As per claims 10-18, the only recited structure per se is a computer system and both the *Source Interactive Software* and *Salmon* teach the use of a computer system, thereby teaching the corresponding structure of the method recited in claims 1-9.

(O) The Appellant states the following:

“With respect to claim 19, this claim was rejected based on reference U, paragraph 1, reference V, paragraph 4, reference X, paragraph 6, and reference X, paragraph 5. Here, again, the Patent Office is merely relying on bits and pieces of the references without concentrating on the subject matter as a whole as required under 35 U.S.C. §103. The rejection does assert a difference in the claims from these references and relies on *Salmon*. But, again, the rejection as relied on states bits and pieces of the reference without considering the subject matter as a whole, as required by 35 U.S.C. §103. Even combining the art applied there is no suggestion of a system to perform that function in the context claimed.

Again, the Appellant is making an assertion without support. It is not clear why the Appellant feels that the rejection of record is deficient. Presumably the Appellant is making reference to arguments already presented earlier in the Appeal Brief. The Examiner has already addressed these arguments above.

(P) The Appellant asserts the following:

“With respect to claim 20, U.S. Patent No. 4,789,928 is relied on. This reference has not been applied in the heading of the claim and, thus, is not a viable reference as set forth in the case of In re Hoch,

Art Unit: 2163

166 USPQ 406 (CCPA 1970) cited in MPEP § 706.02(j).” (Page 16 of Appeal Brief)

The Fujisaki patent (U.S. Patent No. 4,789,928) was not officially part of the rejection. Instead, it was used to provide support for the Official Notice statement made by Examiner Crecca; therefore, the Appellant’s argument is moot.

(Q) The Appellant contends that:

“In the Final Office Action, in Section 2, it was asserted that the several articles to describe the product that the Examiner asserted that the product disclosed in detail in the X reference is the same product which is addressed as early in the U reference. This is unsupported conjecture. The same comment applies to the V reference and the W reference. These added documents do not suffice as evidence that reference X dated back to at least December 14, 1995 as asserted in the rejection.” (Pages 16-17 of Appeal Brief)

The Examiner has met her burden of establishing a prima facie case. The Appellant has failed to adequately challenge the prima facie case. The burden remains with the Appellant to shed doubt on the validity of the cited references. Again, the Examiner cites her reasoning in submitting that all cited references are valid ones:

“The present Examiner asserts that the product disclosed in detail in the X reference (‘IBNL Forges Into the Future of Buying and Selling with Source Interactive Software’) is the same product which is addressed as early as in the U reference entitled ‘Interactive Buyers Net: Buyer/Seller Interactive Software Inc. Acquired, New Software Introduced’ which was published August 22, 1995. The name *Source Interactive Software* is explicitly disclosed as early as November 15, 1995 in the V reference entitled ‘IBNL Announces Signing of More than \$8 Billion in Buyer Power.’ As matter of fact, the article ‘IBNL

Art Unit: 2163

Declares 20 Percent Stock Dividend; SOURCE Interactive Software Systems Operational' (reference W, published December 14, 1995) mentions that Internet access will be available by the first quarter of 1996, which suffices as a disclosure of the Internet embodiment of *Source Interactive Software* dating back at least to December 14, 1995. These facts are further supported by the following excerpt from reference X ('IBNL Forges Into the Future of Buying and Selling with Source Interactive Software'):

"The advent of SOURCE creates a low-cost interactive marketplace where the seller can go to a ready buyer and exactly know his needs.

"Several major players in a diverse range of business sectors already are interactively participating in this marketplace of the future, including Burbank Glendale Pasadena Airport, Los Angeles County ISD,..., among others. Collectively, their accounts boast a pool of buyers in excess of 30,0000 vendors. (Sections 1 and 2)

"The X reference also indicates that *Source Interactive Software* was made public long before January 10, 1996; otherwise, there would not likely be such a large pool of participants by the time said reference was published." (Pages 2-3 of Paper No. 15)

(R) The Appellant asserts that:

"Also, in Section 3 of the Final Office Action, it was asserted in the last sentence of the second paragraph that 'no obligation to cite each and every supporting reference in the body of the rejection since all references collectively contribute to the description of the product Source Interactive Software.' This statement is completely contrary to the law which by mandate the Patent Office must follow. When a reference is cited it must be explained.

"See In re Rijckaert, 28 USPQ2d 1955 (Fed. Cir. 1993) wherein the court stated as follows:

"When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art it must indicate where such a teaching or

Art Unit: 2163

suggestion appears in the reference. (emphasis added)”
(Page 17 of Appeal Brief)

The Examiner did explain all of the cited references. As stated above, the Examiner asserts that references U, V, W, X, U(2), and V(2) were used to show the history of the product *Source Interactive Software*. Collectively these references teach many of the characteristics of the product *Source Interactive Software*. Furthermore, as per *In re Rijckaert*, the Examiner did indicate where all cited teachings or suggestions appeared in the references. It should be noted that, contrary to the Appellant’s assertion, *In re Rijckaert* does **not** state that all prior art references listed in the preamble of a rejection must be explicitly referenced in the body of the rejection.

(S) The Appellant argues the following:

“Also, on page 5, the Patent Office asserts that steps A, B, C, for example, in the method need not be the first, second, and third steps. The rearrangement of the steps in the claims would make no sense when the claim is read as a whole. For example, how could any of the steps a, b, or c be arranged in view of what these steps describe? Thus, what basis the Patent Office is using for this type of assertion is not clear.” (Pages 17-18 of Appeal Brief).

The Appellant’s claim language is very broad. Unless explicitly specified, there is no requirement that steps a, b, and c must occur in any particular order. Furthermore, since the prior art suggests several different variations on the order in which steps (a)-(c) can occur, this serves as proof that steps a, b, and c (of claim 1, for example) may be performed in a variety of algorithmic orders and still maintain their operability.

Art Unit: 2163

(T) The Appellant believes that:

“It was also asserted that presumably product information must come from each respective seller in the Salmon patent; therefore, by ranking products, the sellers are inherency ranked as well. As well known, inherency cannot be used in a § 103 rejection. In any case, it appears that the Examiner is asserting that this is implicit from the references. This is unsupported conjecture. Also, the ranking, as defined cannot be ‘read on’ the references. See, for example, the explanation of ranking as set forth in the Specification and, for example, Figures 11 and 12 of the present specification, and as explained above. Also, the assertion in the Office Action that Salmon anticipates steps e)-g) of claim 1 is not understood. No § 102 rejection has been made. Also, the term ranking as used in the claims on its face would be clear to one skilled in the art. As recognized in the Office Action, the ranking is further described on page 21, second full paragraph. With regards to the term selecting, even by common dictionary definition, this would be understood by one skilled in the art. Furthermore, as set forth in the specification, ranking and selecting have been explained. See, for example, page 4 of the specification, first full paragraph, second full paragraph, and third full paragraph.” (Page 18 of Appeal Brief)

As well-known, an inherency argument may be made in either a rejection under 35 U.S.C. 102 or 35 U.S.C. 103(a). The Examiner used the combination of the product *Source Interactive Software* in view of Salmon to reject claims 1-20; therefore, a 35 U.S.C. 103(a) rejection was necessary. The Examiner stated that one piece of the claim was inherent to the Salmon patent; however, an obviousness rejection still needed to be made to reject the claims in their entirety. Furthermore, many arguments which are valid under 35 U.S.C. 102 (such as inherency) are also valid under 35 U.S.C. 103(a).

Art Unit: 2163

In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., the Appellant's specific definitions of ranking and selecting, as described in the specification) are not explicitly recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Examiner continues to submit that Salmon does teach well-known interpretations of ranking and selecting. Please see at least Figure 5, column 8, lines 22-24, and column 11, lines 38-55.

(U) The Appellant argues the effectiveness of his Supplemental Declaration under 37 C.F.R. § 1.131, which was deemed to be ineffective to overcome the prior art of record (pages 19-21 of Appeal Brief). The Appellant also inquires as to what exact date the Patent Office is relying on for the product *Source Interactive Software* (page 21 of Appeal Brief).

The supplemental declaration is vague and says, "Less than three weeks from the date of January 10, 1996, I worked on drafts of the Exhibit A, title 'High Level Design Automotive Live Market Exchange System.'" Technically, it does not say whether the inventor worked on the drafts three weeks before or after January 10, 1999 and, in a previous declaration under 37 CFR 1.131, the inventor only states that Exhibit A was "published before February 22, 1996." Furthermore, the 103 rejection of record rejects claims 1-20 over the product *Source Interactive Software* in view of Salmon et al. The previous Examiner cited several articles to describe said product. The present Examiner asserts that the product disclosed in detail in the X reference ("IBNL Forges Into the

Art Unit: 2163

Future of Buying and Selling with Source Interactive Software”) is the same product which is addressed as early as in the U reference entitled “Interactive Buyers Net: Buyer/Seller Interactive Software Inc. Acquired, New Software Introduced” which was published August 22, 1995. The name *Source Interactive Software* is explicitly disclosed as early as November 15, 1995 in the V reference entitled “IBNL Announces Signing of More than \$8 Billion in Buyer Power.” As a matter of fact, the article “IBNL Declares 20 Percent Stock Dividend; SOURCE Interactive Software Systems Operational” (reference W, published December 14, 1995) mentions that Internet access will be available by the first quarter of 1996, which suffices as a disclosure of the Internet embodiment of *Source Interactive Software* dating back at least to December 14, 1995. These facts are further supported by the following excerpt from reference X (“IBNL Forges Into the Future of Buying and Selling with Source Interactive Software”):

“The advent of SOURCE creates a low-cost interactive marketplace where the seller can go to a ready buyer and exactly know his needs. “Several major players in a diverse range of business sectors already are interactively participating in this marketplace of the future, including Burbank Glendale Pasadena Airport, Los Angeles County ISD,..., among others. Collectively, their accounts boast a pool of buyers in excess of 30,0000 vendors.” (Sections 1 and 2)

The X reference also indicates that *Source Interactive Software* was made public long before January 10, 1996; otherwise, there would not likely be such a large pool of participants by the time said reference was published. Consequently, the inventor needs to swear behind the *Source Interactive Software* as a whole, **taking into account its earlier date of disclosure (August 22,**

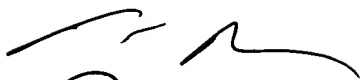
Art Unit: 2163

1995), in order to provide the most effective declaration under 37 CFR 1.131. However, the inventor only need swear back to at least December 14, 1995 to overcome the disclosure of the Internet embodiment of *Source Interactive Software*.

For the above reasons, it is asserted that the rejections should be sustained.

Respectfully submitted,

SMD
May 2, 2001



Tariq Hafiz
Conferee
SPE, Art Unit 2163



TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100



Kyle Choi
Conferee
Examiner, Art Unit 2163